

REMARKS

Claims 3 through 7, 9 through 11, 16 and 17 are pending in this Application. Claims 2 and 3 have been cancelled, new claims 16 and 17 added and the dependency of claims 4, 5, 9 and 10 appropriately changed. Care has been exercised to avoid the introduction of new matter. Specifically, new claim 17 basically corresponds to previous claim 8 dependent on claim 5 now dependent on claim 3. Adequate descriptive support for new claim 16 should be apparent throughout the originally filed disclosure noting, for example, the formula appearing at page 16 of the written description of the specification, line 24, wherein " $n_1 \geq n_3$." Clearly, it is within Applicants' judicial prerogative to narrow the scope of an originally disclosed invention. On that issue the law is clear. In this respect the Examiner's attention is invited to *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). Applicants submit that the present Amendment does not generate any new matter issue.

Objection to the Specification.

The Examiner objected to the specification pursuant to 37 C.F.R. § 1.75(d) asserting that the recited ratio of the optical power propagating through the jacket region to the total optical power propagating through the optical fiber is not described. This objection has been rendered moot by canceling claim 2.

Claims 2 through 7 and 9 through 11 were rejected under the first paragraph of 35 U.S.C. § 112 for lack of adequate descriptive support.

In the statement of rejection the Examiner asserted that the recited ratio of the optical power propagating through the jacket region to the total optical power propagating through the optical fiber was not described. This rejection is traversed. Indeed, this rejection has

been rendered moot by canceling claim 2 wherein the ratio mentioned by the Examiner was previously recited. Accordingly, withdrawal of the rejection of claims 2 through 7 and 9 through 11 under the first paragraph of 35 U.S.C. § 112 is solicited.

Claims 2 through 7 and 9 through 11 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Unger in view of DiGiovanni et al.

In the statement of the rejection the Examiner referred to Figs. 1 through 5 of Unger, asserting the disclosure of a single-mode optical fiber having a core region and a plurality of cladding regions. The Examiner admitted that the Unger does not disclose the concept of providing a cladding region with a plurality of sub medium regions having a refractive index lower than that of the main medium and the use of another fiber for compensating dispersion. The Examiner concluded that one having ordinary skill in the art would have been motivated to modify Unger's optical fiber by providing a cladding region with sub medium regions having a refractive index lower than that of the main medium and to employ another fiber for compensating dispersion in view of the DiGiovanni et al. The Examiner also asserted that the use of an outer jacket is well known in the art. This rejection is traversed.

Independent claim 2 has been cancelled, thereby rendering the imposed rejection moot. All claims now depend from new independent claim 16, which is discussed *infra*. Withdrawal of the rejection of claims 2 through 7 and 9 through 11 is, therefore, solicited.

New independent claim 16, and claims 4 through 7 and 9 through 11 dependent thereon, and new dependent claim 17.

New claim 16 is the only dependent claim. The remaining claims depend directly or indirectly from claim 16. Applicants submit that new independent claim 16 is clearly free of the applied prior art and, hence, the dependent claims are also free of the applied prior art.

Specifically, neither Unger nor DiGiovanni et al. disclose or suggest an optical fiber having the refractive index profile defined in claim 16, particularly the refractive index profile of " $n_1 > n_3$ ". This being the case, even if the applied references are combined, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that new independent claim 16, as well as all dependent claims, are clearly free of the applied prior art and are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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